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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/602,540

06/23/2003

Kimmo Tuomainen

915-005.065

1200

4955

7590

09/10/2008

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ART UNIT

PAPER NUMBER

2179

MAIL DATE

DELIVERY MODE

09/10/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/602,540	<b>Applicant(s)</b> TUOMAINEN ET AL.	
	<b>Examiner</b> MYLINH TRAN	<b>Art Unit</b> 2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/19/08 has been entered.

### ***Specification***

The disclosure is objected to because of the following informalities: the term of "means" is not defined in the specification whether it is a hardware or software. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 19, 21 and 30 are directed to non-statutory subject matter. The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of §101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall

Art Unit: 2179

within a statutory category. They are, at best, functional descriptive material per se.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 and 6-27, 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Inoue et al. [US. 6,332,024].

**As to claims 1, 19, 22 and 24**, Inoue et al. teach displaying a menu on a display of an electronic device (figure 10A), including displaying a plurality of selection elements (figure 6B); activating one of the selection elements ("ENTER or "REGISTER" is selected), and magnifying said one of the selection elements (the selection "ENTER or REGISTER" is highlighted to cause to be more important to indicate magnifying the selection), magnifying said one of the selection elements, and displaying a plurality of auxiliary elements (plurality of elements: G21 and G22) only in the one of the selection elements that has been activated (figure 6C), wherein the plurality of auxiliary elements includes a plurality of directional indicators indicating possible navigating directions for activating another selection

Art Unit: 2179

element other than that said one of the selection elements ((figure 6F, C50, C51 and C52) show the navigating directions); and wherein the method further comprises activating one of the plurality of directional indicators, ending said displaying of the plurality of auxiliary elements in the one of the selection elements, and displaying directional indicators only in said another selection element (column 9, lines 59 through column 10, line 26).

**As to claims 2, 20, 23 and 25**, Inoue et al. teach defining a submenu for the one of the selection elements and displaying said submenu (column 6, lines 13- 40).

**As to claim 3**, Inoue et al. teach activating an element of a submenu and displaying an auxiliary element on the activated element of the submenu (column 6, lines 13-40).

**As to claim 4**, Inoue et al. teach the auxiliary element being not shown in the no-active selection elements (figure 13F, the key "END" is not active selection element).

**As to claim 6**, Inoue et al. teach the indicator being an arrow pointing to one possible navigating direction (figure 13E, arrows G 41-42 show the navigating directions).

**As to claim 7**, Inoue et al. teach another auxiliary element in the one of the selection elements that has been activated, displays a selectable function (figure 13B, the key "Host 1" is selected).

**As to claim 8**, Inoue et al. teach the selectable function being accessible via a shortcut (figure 13F, "envelope" is a mail indicator).

Art Unit: 2179

**As to claim 9**, Inoue et al. teach said auxiliary element being located close to an identifier of the active selection element (figure 13F, a next element closes to the "envelop" element).

**As to claims 10 and 18**, Inoue et al. teach an identifier of the selection element is at least one the following: an icon, an object, a figure, a text, or a cell of a menu (figure 13F).

**As to claim 11**, Inoue et al. teach an electronic device configured to perform at least a plurality of operations (1A); a graphical user interface, a function of the interface being to present various menus for said plurality of operations (figures 66C-6E); wherein said interface has a the display format comprising one or more selection elements (figure 13E), at least one selection element comprising an auxiliary element (figure 13E, arrows G 41-42 show the navigating directions, column 16, lines 19-45), and only an active selection element comprising a visible auxiliary element (the selection "NEWS" is highlighted to indicate magnifying the selection); wherein the interface is configured to hide said auxiliary element in the active selection element upon navigating to said another selection element (figure 6F, C50), and is configured to provide a newly visible auxiliary element in said another selection element (column 9, lines 59 through column 10, line 26).

**As to claim 12**, Inoue et al. teach at least one magnified selection element of the first selection element level (figure 13B, "Host 1" is selected).

**As to claim 13**, Inoue et al. teach the auxiliary element comprising at least

Art Unit: 2179

one indicator indicating the possible navigating direction (figure 13E, arrows G 41- 42 show the navigating directions, column 16, lines 19-45).

**As to claim 14**, Inoue et al. the indicator being an arrow pointing to one possible navigating direction (figure 13E, arrows G 41-42 show the navigating directions, column 16, lines 19-45).

**As to claim 15**, Inoue et al. teach the auxiliary element comprising at least one indicator indicating the selectable function (figure 13F, G41 is the selectable function).

**As to claim 16**, Inoue et al. teach the indicator being a shortcut menu (figure 13E).

**As to claim 17**, Inoue et al. teach the selection element comprising an identifier of the element and an auxiliary element which are located close to said identifier (figure 13F, a next element closes to the "envelop" element).

**As to claim 21**, Inoue et al. teach a graphical user interface, a function of the interface being to present various menus, and one or more selection elements presented via the interface, at least one selection element comprising an auxiliary element and only an active selection element comprising a visible auxiliary element (column 7, lines 25-57);

wherein said visible auxiliary element is configured to navigate to another selection element ("ENTER" is selected in figure 6B to display two other elements of C21 and C22); and wherein the interface is configured to hide said auxiliary element in the active selection element upon navigating to said another selection element (C21 and C22) is hide under the element

Art Unit: 2179

“ENTER”), and is configured to provide a newly visible auxiliary element in said another selection element (column 9, lines 59 through column 10, line 26).

**As to claim 26**, Inoue et al. teach means for presenting various menus (figure 13B-F), wherein at least one of the menus comprising a plurality of selection elements (“NEWS” is selected); means for activating on of the selection elements; and means for magnifying said one of the selection elements (the selection “NEWS” is highlighted to indicate magnifying the selection); wherein at least one of the selection elements comprising an auxiliary element, wherein only an active selection element comprising a visible auxiliary element and wherein the at least one auxiliary element including at least one directional indicator indicating possible navigating directions for activating an other selection element (figure 13E, arrows G 41-42 show the navigating directions, column 16, lines 19-45); and wherein the mobile phone is configured to stop displaying said visible auxiliary element in the active selection element ((C21 and C22) is hide under the element “ENTER”), after activation of said visible auxiliary element, and is configured to start displaying directional indicators only in said other selection element ((column 9, lines 59 through column 10, line 26).

**As to claim 27**, Inoue et al. teach means for presenting a submenu for the one of the selection elements (figures 13B-F).

**As to claim 30**, Inoue et al. teach means for performing at least a plurality of operations (column 1, line 50 through column 2, line 13); means for



Art Unit: 2179

presenting various menus for said plurality of operations (figures 6A-6H); wherein said means for presenting has a display format comprising one or more selection elements (figures 6A-6D); wherein at least one selection element comprises an auxiliary element ("ENTER" is selected to display C21 and C22), wherein only an active selection element comprises a visible auxiliary element (figure 6C, C21 and C22), wherein said visible auxiliary element is configured to navigate to another selection element (C21 and C22 indicate to navigate to another selection element), and wherein said means for presenting is also for hiding said auxiliary element in the active selection element upon navigating to said another selection element ((C21 and C22) is hide under the element "ENTER"), and is also for providing a newly visible auxiliary element in said another selection element (column 9, lines 59 through column 10, line 26).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 28-29 and 31 rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue et al.

Art Unit: 2179

**As to claims 28 and 31**, Inoue et al. fail to clearly teach magnifying of said one of the selection elements includes increasing an apparent size of said one of the selection elements. However, Inoue et al. teach the step of highlighting the selection elements to cause them to seem greater and more important. It was well known in the art that highlighting the selection elements to cause to seem greater and more important of the selection elements being similar to increase an apparent size of the elements. It would have been obvious to one of skill in the art, at the time the invention was made, to highlight the selection elements. Motivation of the combination would have been to enhance the display of the element to indicate the selectable elements.

**As to claim 29**, Inoue et al. fail to teach a personal digital assistant. However, Inoue et al. teach a portable terminal comprising a LCD display screen located on a control surface of a case. Official notice is taken that the portable terminal being the personal digital assistant was well known in the art. It would have been obvious to one of skill in the art, at the time the invention was made, to make the portable terminal being the personal digital assistant. Motivation of the combination would have been for the ease of carrying.

### **Response to Arguments**

Applicant has argued that Inoue et al. do not teach or suggest the step of magnifying. Magnifying and Highlighting are not similar actions. However,

Art Unit: 2179

Inoue et al. teach the step of highlighting the selection elements to cause them to seem greater and more important. It was well known in the art that highlighting the selection elements to cause to seem greater and more important of the selection elements being similar to increase an apparent size of the elements. It would have been obvious to one of skill in the art, at the time the invention was made, to highlight the selection elements.

Motivation of the combination would have been to enhance the display of the element to indicate the selectable elements.

Applicant has argued that Inoue does not disclose selection elements comprising auxiliary elements. However, Applicant's attention is directed to figures 6A-6H. Inoue teaches including displaying a plurality of selection elements (figure 6B); activating one of the selection elements ("ENTER" is selected), and magnifying said one of the selection elements (the selection "ENTER" is highlighted to indicate magnifying the selection), magnifying said one of the selection elements, and displaying an auxiliary element only in the one of the selection elements that has been activated (figure 6C), wherein the at least one auxiliary element includes at least one directional indicator indicating possible navigating directions for activating an other of the selection elements displayed outside said one of the selection elements (figure 6C, arrows G 21-22 show the navigating directions).

When "ENTER" is selected (figure 6B), a new display screen with a selected element (figure 6C, C20) is displayed. It is clear that Inoue teaches displaying an auxiliary element only in the one of the selection elements.

Art Unit: 2179

Applicant has also argued that Inoue does not teach or suggest magnifying a selection element, However, "ENTER, is magnified by enlarging its size in figure 6B.

Inoue also teaches the feature of "displaying an auxiliary element only in the one of the selection elements that has been activated."

All the text elements are displayed in figure 6C that are auxiliary elements when the "ENTER" key is activated.

G42 and G43 used for navigating between previously visited pages and menus. They are still the browser function buttons indicating navigation directions for activating another of the selection elements.

It is noted that the claimed language itself "directional indicator indicating possible navigating directions for activating an other of the selection elements displayed outside of the selection elements." is not specific and clear enough to describe the invention specification. The term of "activating an other of the selection elements displayed outside of the selection elements" is a broad term. During patent examination, the pending claims must be "given >their broadest reasonable interpretation consistent with the specification." > In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See In re Van Geuns, 988 F.2d 1181,26 USPQ2d 1057 (Fed. Cir. 1993). Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the

Art Unit: 2179

possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541,550-51 "(CCPA 1969).

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mylinh Tran. The examiner can normally be reached on Mon - Thu from 7:00AM to 3:00PM at 571-272-4141. The fax phone numbers for the organization Where this application or proceeding is assigned are as follows:

571-273-8300

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 2179

Mylinh Tran

Art Unit 2179

/Stephen S. Hong/

Supervisory Patent Examiner, Art Unit 2178